

42 In re/Patent Application of

MAIL STOP AF

Group Art Unit: **3627**

Examiner: Oger Garcia Ade

Confirmation No.: 1270

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This Notice of Appeal and Pre-Appeal Brief Conference Request is in response to the Advisory Action dated May 7, 2007.

The claimed "list of unpriced performances desired by a buyer" describes the data and information derived from a database that is exchanged between a buyer and a potential bidder. Therefore, the Appellant respectfully submits that in the context of a business method and process claim, the characterization, by the Examiner, of the "list of unpriced performances desired by a buyer" as descriptive material is misplaced.

The list of unpriced performances facilitates an interaction between the buyer, who generated the list, and the bidder, who receives the data and information derived from the database, and must input numbers based on what the bidder expects to be paid for completing the listed performance.

The forwarded list of unpriced performances must have areas where data is input, which when the data is input, particularly in the context of a computer, structurally changes the list. The inputted data also creates an interrelationship between the list of performances desired by the buyer and the prices input by the bidder.

Therefore, the Appellant respectfully submits that the list of unpriced performances imparts functional elements because the claimed elements need the requisite function for the performance of the claimed method.

B. Alleged Non-Functional Descriptive Material is the basis for a 35 U.S.C. §101 rejection, not a prior art rejection.

In the Advisory Action, the Examiner asserts that the newly claimed feature of "list of unpriced performances" is merely non-functional descriptive material because it neither "enhances nor diminishes" the functionality of the system. The Advisory Action further states that the alleged descriptive material is not given any patentable weight.

Appellant respectfully submits that the assertion of non-descriptive functional material is a basis for a 35 U.S.C. §101 rejection and not a prior art rejection.

MPEP §2106 (VII) states:

Once USPTO personnel have concluded the above analyses of the claimed invention under all the statutory provisions, including 35 U.S.C. 101, 112, 102 and 103, they should review all the proposed rejections and their bases to confirm that they are able to set forth a *prima facie* case of unpatentability. Only then should any rejection be imposed in an Office action. The Office action should clearly communicate the findings, conclusions and reasons which support them.

Appellant respectfully submits that the claims have not been properly rejected under any of USC §§101, 112, 102 or 103. Therefore, the previous Office Action

should be withdrawn and a new Office Action addressing all of the claim limitations should be provided, so all issues for Appeal are clearly in the record.

C. The Fields publication does not disclose or suggest all of the claimed features.

Even assuming, *agruendo*, that the "unpriced performance" is descriptive material, Appellant submits that the Fields publication does not disclose or suggest the all of claimed features. For example, Fields publication does not disclose or suggest receiving a bid from at least one of the plurality of bidders, each received bid including a bid price input to a bid mask by the bidder.

As explained at page 15 of Appellant's response filed April 4, 2005, the Fields publication describes a system where the attorney, who receives the RFP, can only accept, reject or delete the RFP. The attorney (bidder) can not input a bid price into a bid mask as recited in the claim.

D. The Final Office Action does not address Applicant's arguments.

The Examiner states in the Advisory Action that the claim feature of "unpriced performances" is merely descriptive material, is not given patentable weight, and, accordingly, does not need to be addressed in a prior art rejection.

All claim limitations must be considered when determining patentability of an invention of the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 403-04 (Fed. Cir. 1983).

The invention in *Gulack* was directed to a hat band-like device imprinted with a cyclic series of numbers for educational and recreational purposes.

In re Gulack further states:

Differences between invention and prior art cited against it cannot be ignored merely because those differences reside in content of printed matter. Under Section 103, the board cannot dissect claim, excise printed matter from it, and declare remaining portion of the mutilated claim to be unpatentable. The claim must read as whole. (emphasis added). 217 USPQ at 403.

In the final Office Action, the Examiner did not provide any response to the Appellant's arguments or consider all of the claim limitations when making the final rejection as required by *In re Gulack*. Therefore, the Appellant requests withdrawal of the final Office Action and reconsideration of all of the claim limitations.

E. Conclusion

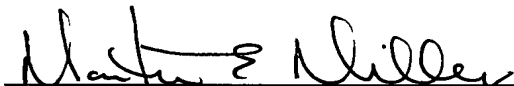
Appellant respectfully submits that the "list of unpriced performances" is not descriptive material. Appellant requests that the rejections in the final Office Action be reconsidered and be withdrawn.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: June 1, 2007

By:



Martin E. Miller

Registration No. 56022

P.O. Box 1404
Alexandria, VA 22313-1404
703 836 6620